



Paper No. 3

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OFFICE OF PETITIONS

In re Reissue Application of
James W. Scheik, Sr.
Application No. 09/641,378
Deposited: August 18, 2000
Attorney Docket No. 074309.00014

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: NOTICE OF INCOMPLETE
: APPLICATION
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The above-identified application was referred to the Office of Patent Legal Administration for review.

The application was deposited on August 18, 2000, as a reissue application of U.S. Patent No. 6,053,883. A review of the application papers reveals that the application was deposited without drawings. It is noted that the application transmittal letter does not indicate that drawings were being submitted. Also, the filing receipt for the application does not indicate that any sheets of drawings were present. The specification, however, refers to Figures 1-6.

When the reissue application was deposited, 37 CFR 1.174(a) stated the following:

The drawings upon which the original patent was issued may be used in reissue applications if no changes whatsoever are to be made in the drawings. In such cases, when the reissue application is filed, the applicant must submit a temporary drawing which may consist of a copy of the printed drawings of the patent or a photoprint of the original drawings of the size required for original drawing.

While 37 CFR 1.174 has since been removed, 37 CFR 1.173(a)(2) now requires "a clean copy of each drawing sheet of the printed patent at the time the reissue application is filed."

Any assertions that the drawings were submitted, or are not necessary for a filing date, must be by way of petition accompanied by the \$130.00 petition fee (37 CFR 1.17(h)). If the petition states that the application is entitled to a filing date, a request for refund of the petition fee may be included in the petition. It is noted that a postcard receipt which itemizes and properly

identifies the papers which are being filed serves as *prima facie* evidence of receipt in the Office of all the items listed thereon on the date stamped thereon by the Office. See Section 503, Manual of Patent Examining Procedure (MPEP 503). Thus, if applicant has a postcard receipt acknowledging receipt of sheets of drawings, it should be submitted along with the petition.

The requirement for a temporary drawing in a reissue application is a requirement of the rules. Therefore, if the drawings were not submitted with the reissue application when the reissue application was filed or if applicant does not have a postcard receipt acknowledging receipt of the drawings, applicant should consider filing a petition under 37 CFR 1.183, accompanied by the \$130.00 petition fee, to waive the requirement that a copy of the drawings of the printed patent be submitted when the reissue application is filed.

A copy of the drawings of the printed patent are still required for the application to be complete and must be submitted with any petition or reply to this Notice.

A further review of the application reveals that the signature to the declaration is by a person other than the inventor or person qualified under 37 CFR 1.42, 1.43, or 1.47. The declaration is signed by John Scheik, Vice President of Scheik's Sports, Inc., the assignee. The declaration indicates that "[t]he inventor, James W. Scheik, Sr. has refused to sign any additional documentation related to U.S. Patent No. 6,053,883, to which he is not entitled." While 37 CFR 1.172 provides that a reissue declaration may be made by the assignee of the entire interest if the application does not seek to enlarge the scope of the claims of the original patent, the declaration in this case alleges the original patent to be partly invalid because of the inventor claiming less than he had a right to claim. Furthermore, the declaration does not identify the country of citizenship and the residence of the inventor as required by 37 CFR 1.63. A properly signed oath or declaration in compliance with 37 CFR 1.63, identifying the application by application number and filing date, is required. If the inventor refuses to sign the oath or declaration, a petition under 37 CFR 1.47 (accompanied by the \$130.00 petition fee) is required. See MPEP 409.03 and 409.03(b) for the requirements of such a petition.

In addition, consent of the assignee is missing. 37 CFR 1.172 requires that the reissue oath or declaration be accompanied by the written consent of all assignees. Furthermore, assignee's statement under 37 CFR 3.73(b) establishing ownership of the patent is missing. 37 CFR 1.172 requires that all assignees consenting to the reissue application establish their ownership interest in the patent by filing in the reissue application a statement in accordance with 37 CFR 3.73(b). While the reissue transmittal letter indicates that a statement under 37 CFR 3.73(b) was being submitted and the offer to surrender the original patent indicates that a certificate under 37 CFR 3.73(b) is attached, no statement under 37 CFR 3.73(b) has been located among the application papers.

Applicant is given **TWO MONTHS** from the date of this Notice to submit the missing drawings, any appropriate petition(s), a signed oath or declaration in compliance with 37 CFR 1.63, written consent of the assignee, and assignee's statement under 37 CFR 3.73(b), as required above. The **\$65.00 surcharge** for a small entity under 37 CFR 1.16(e) is **required** for the late filing of the declaration (unless applicant accepts the filing date as the date of receipt of the missing drawings and the declaration is filed therewith). The filing date will be the date of receipt of the missing drawings unless a grantable petition requesting that the application be accorded a filing date of August 18, 2000, is submitted. Failure to complete the application within this time period will result in the return of the application to Initial Patent Examination Division for processing as an incomplete application (no filing date granted) (See 37 CFR 1.53(e)). The reply should be directed as follows:

By mail: Assistant Commissioner for Patents
Box DAC
Washington, D.C. 20231

By hand: Crystal Plaza Four, Suite 3C23
2201 South Clark Place
Arlington, VA

The application is being retained in the Office of Patent Legal Administration to await a reply to this Notice.

Telephone inquiries specific to this matter should be directed to the undersigned at (703) 306-5586.



Eugenia A. Jones
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy